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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex Parte KLAUS SCHULTES et al.

Appeal 2010-005278
Application 10/539,132
Technology Center 1700

Oral Hearing Held: Tuesday, April 12, 2011

16 Before CHUNG K. PAK, KAREN M. HASTINGS and
17 MICHAEL P. COLAIANNI, Administrative Patent Judges

19 ON BEHALF OF THE APPELLANT:

HARRIS A. PITLICK, ESO.

Oblon, Spivak, McClelland, Maier & Neustadt, LLP

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1 *The above-entitled matter came on for hearing on Tuesday,*
2 *April 12, 2011, commencing at 10:25 a.m., at the U.S. Patent and*
3 *Trademark Office, 600 Dulany Street, 9th Floor, Hearing Room A,*
4 *Alexandria, Virginia, before B. Stanley Ross, notary public.*

5

6 JUDGE PAK: Mr. Pitlick, welcome.

7 Mr. Pitlick, you've got 20 minutes, and you can start anytime
8 you wish.

9 MR. PITLICK: Okay. The invention here is a process for
10 preparing an aqueous polymer dispersion of what's currently known as a --
11 basically a core shell polymer.

12 The process begins with a particular starting material. You get
13 a certain seed particle radius, and then you have a number of compositions
14 emulsified -- emulsified form to get the core of your shell and your shell.

15 The most important, let's say, element of this particular
16 invention is the combination of having, in effect, a solid amount of at least
17 50 percent, together with a coagulate amount of -- quite low -- it's than 0.1
18 percent -- I'm sorry -- 0.1 percent or less by weight, and we've disclosed in
19 the specification various prior art processes that are somewhat similar but
20 have not been able to obtain this combination of high solids content and low
21 coagulate content.

22 We do have some comparative data in the specification which
23 shows that similar monomer compositions for the various core and shell

1 layers still were not able to achieve both the combination of a high solids
2 content and a low coagulum amount.

3 So, the rejections here -- there are basically three sets of
4 rejections, all prior art rejections. They all rely on Hoffman et. al -- sorry,
5 just Hoffman -- and the examiner alternatively relies on three other
6 references -- to wit, Takarabe et. al and Morningstar et. al -- and then there's
7 some further rejections along another art dealing with some of the other
8 dependent claims.

9 I think the briefs pretty much set forth our position, and there is
10 really no prima facie case, but nevertheless, the comparative data still needs
11 to be considered for purposes of patentability.

12 The comparative samples which we've described in the
13 specification and which we also rely on are actually closer than any of the
14 examples or compositions relied on by the applied prior art, and in view of
15 cases such the Ex parte Humber Board decision, which is still valid, which
16 we cite, certainly, as I say, the comparative data is closer to any of the art
17 and certainly it's valid to consider that for the comparative examples.

18 That's basically it in a nutshell, and I'll be happy to answer any
19 questions you might have.

20 JUDGE COLAIANNI: I have a question. I notice you had
21 some product-by-process claims, I think 29 onward. How does that analysis
22 you just described square with the examiner's case, which is that, you know,
23 you have a similar composition, similar method, so why is the product
24 necessarily different?

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1 MR. PITLICK: Well, the comparative data shows that there are
2 differences in the product, and so, I know when you have a product by
3 process and the product appears to be at least similar if not the same as the
4 art, you've got to show that the process basically lends certain compositional
5 limitations or changes to the composition. I think the comparative data
6 actually shows that.

7 JUDGE PAK: Any other questions?

8 Thank you for coming. We will consider the argument.

9 (Whereupon, at 10:30 a.m., the proceedings were concluded.)

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